

PATENT  
0879-0242P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:       Atsushi MISAWA                      Conf.:       9612  
Appl. No.:       09/432,087                      Group:       2835  
Filed:           November 2, 1999                      Examiner: A. VORTMAN  
For:             ARRANGEMENT OF CARD SLOT IN LAPTOP COMPUTER

**REQUEST FOR REVIEW BY SUPERVISORY PRIMARY EXAMINER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

April 18, 2005

Sir:

In accordance with the provisions of MPEP § 707.02, Applicant respectfully requests that **the Supervisory Primary Examiner personally check on the pendency of the present application.** This application has now received ten (10) Office Actions.

**Prosecution History**

On March 2, 2001, the Examiner issued the first Office Action rejecting originally filed claims 1-7 and 9-12 under 35 U.S.C. § 102(e) as being anticipated by *Smith* (USP 5,768,163). The Examiner indicated that claim 8 contained allowable subject matter.

In the Reply filed June 4, 2001, Applicant added new claims 13-17 and argued that *Smith* failed to anticipate the originally-filed claims and the pending claims.

The Examiner issued his second Office Action on August 15, 2001, maintaining his rejection of the claims but, curiously, responding to Applicant's arguments by asserting "Applicant's arguments ... have been considered but are moot in view of the new grounds of rejection."

In Applicant's Reply filed December 17, 2001, Applicant requested that the Examiner properly respond to the arguments included in the previous Reply. Further, Applicant noted that the Examiner failed to properly consider new claims 13-17. Applicant requested the Examiner properly consider the newly-added claims.

In the Examiner's third Office Action mailed January 18, 2002, the Examiner withdrew his previous rejections and asserted a new grounds of rejection under 35 U.S.C. § 102(e) citing *Ma* (USP 5,880,928) with regard to claims 1-7, 9, and 11.

In the Reply filed April 10, 2002, Applicant added new claims 18-23 and responded to the Examiner's rejections by asserting *Ma*

failed to teach or suggest a chamber capable of accepting an external device as recited in the claims.

In the Examiner's fourth Office Action, the Examiner maintained his rejection of the claims by asserting that an external device is defined, in a personal computer, as a device that is not physically contained within the main cabinet.

In Applicant's Reply filed August 15, 2002, Applicant amended the claims to recite, for example, a chamber capable of interchangeably accepting an external device. Applicant further argued that as the cameras and sound boxes of *Ma* were permanently connected to the computing device that *Ma* failed to teach or suggest this feature. The Examiner indicated that the amendments contained new issues and did not enter Applicant's Reply in an Advisory Action mailed September 20, 2002.

On September 11, 2002, Applicant filed a Request for Continued Examination requesting entry of the Reply After Final and further requesting an interview with the Examiner. On October 16, 2002, an interview was conducted. During the interview, the Examiner asserted that as, with regard to claim 1, the claim contained a functional recitation, that he was not providing patentable weight to the functional recitation.

Subsequently, the Examiner issued the fifth Office Action on October 28, 2002, maintaining his rejection of the claims and suggesting that in order to be given patentable weight, the

functional recitation must be expressed in means-plus-function format.

In the Reply filed January 23, 2003, Applicant argued that the Examiner was misinterpreting the case law and advised the Examiner that the recitations found in the body of the claim should be afforded patentable weight and requested that the Examiner properly consider the claims.

The Examiner maintained his rejection of the claims in the sixth Office Action mailed March 4, 2003, maintaining that the elements set forth in the body of the claim should not be afforded patentable weight.

In the Reply filed June 3, 2003, Applicant amended the claim to recite, for example, a chamber capable of accepting a removable external device. The Examiner, in an Advisory Action mailed June 16, 2003, indicated that the new claim amendments would require further consideration and did not enter the Reply.

Applicant filed a second Request for Continued Examination on June 24, 2003, requesting the Examiner enter the Reply and consider the amendments. However, in the seventh Office Action mailed July 17, 2003, the Examiner again maintained his rejection of the claims without providing any additional support for these assertions.

These arguments proceeded back and forth between the Examiner and the Applicant in Applicant's Reply filed October 16, 2003, and

the eighth Office Action mailed December 11, 2003.<sup>1</sup> Given the extensive prosecution history, the Applicant contacted the Examiner by telephone on two separate occasions to seek the Examiner's opinion on what amendments he believed needed to be made in order to make the claims allowable. The Examiner again erroneously asserted that the claims needed to be rewritten in means-plus-function format in order to afford patentable weight to the functional language of the claim.

Based on these discussions with the Examiner, Applicant filed a Notice of Appeal to the Board of Appeals on March 10, 2004, and submitted the appropriate Appeal Brief on May 10, 2004.

Presumably, upon review of the outstanding rejections at the Appeal Conference, the Examiner withdrew all of the outstanding rejections and issued the ninth Office Action in this case on June 29, 2004, asserting a new grounds of rejection under 35 U.S.C. § 102 as being anticipated by *Chang et al.*

In response to the Examiner's newly-cited art, Applicant filed a Reply on November 29, 2004, submitting a Declaration of Prior Invention in a WTO Member Country to Overcome a Cited Patent Pursuant to 37 C.F.R. § 1.131. In the properly-executed Declaration, the sole inventor provided sufficient evidence to remove the *Chang et al.* reference as prior art. Additionally,

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<sup>1</sup> A second non-Final Office Action was provided by the Examiner due to the Examiner's failure to consider all of the pending claims.

arguments were included that the second 35 U.S.C. § 102 reference failed to anticipate the pending claims.

On January 18, 2005, the Examiner issued a Final Office Action, asserting that the Declaration was ineffective to overcome the *Chang et al.* reference. The Examiner based this decision on the lack of dates included in the exhibit presented with the Declaration. Clearly, the Examiner did not lend any weight to the evidence presented in the Declaration properly executed by the inventor. Further, in response to Applicant's arguments regarding the deficiencies of *Scheer*, namely that the reference fails to teach or suggest "wherein the display unit comprises at least one of a cutout part and a transparent part so that whether the external device is inserted in the chamber can be determined by seeing through the at least one of the cutout part and the transparent part", the Examiner merely copies his rejection which comprises one sentence used to reject eighteen claims.

#### ***Applicant's Request***

It appears to the Applicant that the Examiner has failed to again properly perform his duties as an Examiner and in accordance with the guidelines as set forth in the MPEP, specifically § 715.07, by failing to consider all submitted evidence, including the evidence included in the inventor's Declaration. Further, the Examiner has again failed to properly respond to Applicant's

arguments particularly noting which portion of the reference the Examiner is relying upon in support of his rejection of the claims, specifically as it relates to the cutout part and the transparent part as claimed. Applicant's arguments are more fully set forth in the Reply After Final filed concurrently herewith.

As set forth in MPEP 706.07, "[t]o bring the prosecution to a speedy conclusion as possible and at the same time to deal justly by both the Applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied.... It is to the interest of the Applicants as a class as well as to that of the public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits."

MPEP §707.02 states that "the Supervisory Primary Examiners are expected to personally check on the pendency of every application which is up for the third or subsequent official action with a view to finally concluding its prosecution."

Accordingly, Applicant respectfully requests that the Supervisory Primary Examiner acknowledge that the pendency of the present application has been personally checked in the next Office Action.

**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at telephone number (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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